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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,416	03/06/2002	Gerald Cagle	1733 US FA	1351

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EXAMINER
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WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 08/15/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/092,416

Applicant(s)

CAGLE ET AL.

Examiner

Shengjun Wang

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

The application is a continuation of U.S. application No. 09/646,798.

***Claim Rejections 35 U.S.C. 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Cetenko et al. (US 5,143,928, IDS AA2).
3. Cetenko et al. teaches a pharmaceutical composition comprising therapeutical effective amount of oxazolidinone and a pharmaceutical acceptable carrier. See, particularly, the abstract, and claim 45. Cetenko et al. also teach pharmaceutical composition comprising both oxazolidinone and cyclooxygenase inhibitor or NSAIDs. See, particularly, column 9, lines 10-28. The carrier may be chosen accordingly to the dosage form, including eye drop. See, particularly, col. 7, lines 48-62.
4. Claims 1 and 6 are rejected under 35 U.S.C. 102(e) as being anticipated by Cochran et al. (US 6,337,329, IDS AA4).

5. Cochran et al. teaches an ophthalmologic composition comprising an oxazolidinone and a method of using the same for treating eye infection. See, particularly, examples 6 and 7 in col. 6, and the claims.

***Claim Rejections 35 U.S.C. 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4, 6, and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cagle (WO 90/01933, IDS) in view of Fajardo et al.

8. Cagle teaches a composition comprising an antibiotics and steroids and the method of using the same for controlling infection and inflammation in eye. The steroid agents are rimexolone, dexamethasone, fluorometholone, and prednisolone. See the abstract.

9. Cagle does not teach expressly to employ oxazolidinone as the antibiotics in the combination.

10. However, Fajardo et al. teaches an oxazolidinone which is useful as an antibiotic ophthalmic agent. Fajardo et al. also teaches that this drug is valuable for treating eye infections that have failed to response to other antibiotics. See, particularly, page 114, both columns, page 117, left column, and page 118, left column.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the oxazolidinone disclosed by Fajardo et al. in Cagle's ophthalmic composition.

A person of ordinary skill in the art would have been motivated to employ the oxazolidinone disclosed by Fajardo et al. in Cagel's ophthalmic composition because the oxazolidinone is known to be useful in ophthalmic composition as antibiotics for treating antibiotics-resistant eye infection.

11. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Castillo et al. (US 5,520,920, IDS), in view of Fajardo et al. (IDS).

12. Castillo et al. teaches an antimicrobial ophthalmic composition comprising steroid and non-steroid anti-inflammatory agents and other ophthalmic agents. See, particularly, col. 3, line 58 to col. 4, lines 5.

13. Castillo et al. does not teach expressly the employment of an oxazolidinone in the composition.

14. However, However, Fajardo et al. teaches an oxazolidinone which is useful as an antibiotic ophthalmic agent. Fajardo et al. also teaches that this drug is valuable for treating eye infections that have failed to response to other antibiotics. See, particularly, page 114, both columns, page 117, left column, and page 118, left column.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to employ the oxazolidinone disclosed by Fajardo et al. in Castillo's ophthalmic composition.

A person of ordinary skill in the art would have been motivated to employ the oxazolidinone disclosed by Fajardo et al. in Castillo's ophthalmic composition because the oxazolidinone is known to be useful in ophthalmic composition as antibiotics for treating antibiotics-resistant eye infection. Further, it is prima facie obvious to combine two compositions

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each of which is taught in the prior art to be useful for same purpose in order to form third composition that is to be used for very the same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, the claimed invention which is a combination of two known ophthalmic compositions sets forth prima facie obvious subject matter. See In re Kerkhoven, 205 USPQ 1069.

15. Claims 2, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cetenko et al. (US 5,143,928, IDS AA2).

16. Cetenko et al. teaches a pharmaceutical composition comprising therapeutical effective amount of oxazolidinone and a pharmaceutical acceptable carrier. See, particularly, the abstract, and claim 45. Cetenko et al. also teach pharmaceutical composition comprising both oxazolidinone and cyclooxygenase inhibitor or NSAIDs. See, particularly, column 9, lines 10-28. The carrier may be chosen accordingly to the dosage form, including eye drop. See, particularly, col. 7, lines 48-62.

17. Cetenko does not teach expressly the combination of the oxazolidinone with other anti-inflammatory agents for eye treatments.

18. However, Cetenko teaches broadly that the oxazolidinone is useful as anti-inflammatory agents in various forms, including eye drop. See, particularly, col. 7, lines 55-56. Cetenko further teaches that the oxazolidinone are particularly useful in combination with NSAID. See, particularly, col. 9, line 10 to col. 11, lines 23.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to combine the oxazolidinone with NSAID for treating eye infection.

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A person of ordinary skill in the art would have been motivated to combine the oxazolidinone with NSAID for treating eye infection because the oxazolidinone are known to be useful for treating eye inflammation, and is particularly useful in combination with NSAID.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Patent Examiner



Shengjun Wang

Shengjun Wang

August 14, 2003